

REMARKS

Applicant has carefully studied the Office Action of May 4, 2005, and offers the following remarks in response thereto. Applicant appreciates the telephonic interview of June 22, 2005 when a few issues were discussed with Examiner Smith. Where appropriate, Applicant includes remarks from the interview below, and these marks serve as the Interview Summary required by the MPEP.

Initially, Applicant appreciates the indication that claims 5-7, and 22-24 contain allowable subject matter, but in light of the deficiencies in the rejection of the independent claims, Applicant does not amend the claims at this time.

Claims 1, 2, 4, 9-19, 21, and 25-34 were rejected under 35 U.S.C. § 103 as being unpatentable over Ljubicich or Vasa in view of Sakata. Applicant respectfully traverses. For the Patent Office to combine references in an obviousness determination, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). The fact that references can be combined is not sufficient to establish *prima facie* obviousness. MPEP § 2143.01. Likewise, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Id.*

Applicant traverses the rejection because the Patent Office's analysis about why the references would be combined is deficient. The Patent Office asserts that:

To have used Sakata's teaching of sending a pointer back to the requesting terminal instead of either Ljubicich's access number or Vasa's addresses that the user then will use to locate the information in either Ljubicich or Vasa's apparatus would have been obvious. . .because to substitute a pointer for an access number when one is requesting information would be within the purview of the skilled artisan with these references in front of her.

(Office Action of May 4, 2005, page 3, line 22-page 4, line 5). This statement does not contain a motivation to combine the references. That is, the Patent Office has not articulated the reason why the "skilled artisan" would make such a substitution. As noted above, merely because the references can be combined is not sufficient to establish obviousness. Likewise, the fact that the invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish obviousness. Under either standard, the Patent Office's analysis is deficient. Since the Patent

Office has not provided any reason why the references would be combined, the combination is improper. Since the combination is improper, the rejection based on the combination is improper. Since the rejection based on the combination is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the rejection on this basis.

Applicant further notes that if the Patent Office's statement has some motivation therein (a point which Applicant does not concede), the Patent Office has not supported the motivation with any evidence as required by the Federal Circuit. That is, the Patent Office has pointed to no evidence as to why the combination would be within the purview of a "skilled artisan". Since the Patent Office has not provided the requisite actual evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection based on the combination is improper. Since the rejection based on the combination is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the rejection on this basis as well.

During the telephonic interview, Applicant requested clarification for the motivation to combine the references. Examiner Smith indicated that the motivation would be "ease of use", and opined that the combination reduces the need to write down a telephone number and then manually punch the telephone number into the mobile terminal. Applicant appreciates the clarification as to the motivation to combine the references, but traverses the articulated motivation. Applicant initially notes that this motivation is essentially the motivation set forth in the background of Applicant's disclosure in paragraph 0002 of the specification. Use of Applicant's disclosure to guide the combination of references constitutes impermissible hindsight reconstruction. To cleanse the articulated motivation of the possibility of impermissible hindsight reconstruction, the Patent Office must provide evidence apart from Applicant's disclosure that supports this motivation. In the absence of such evidence, the motivation is improper, and the rejection based on the motivation is improper. Since the rejection is improper, Applicant requests withdrawal of the § 103 rejection and claim allowance on this basis.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. The Patent Office has not articulated a proper reason to combine the references, nor has

the Patent Office provided the requisite evidence to support the reason to combine the references.
Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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